REMARKS

Request for Withdrawal of Final Action

The finality of the present action is not proper. The rejections of claim 1 under 35 U.S.C. § 103(a) in the present action over de Toledo and Arenas under 35 U.S.C. § 103(a) are new grounds of rejection that were not necessitated by applicant's amendment of claim 1 in the response to the first action of December 1, 2005.

In the first action, Claims 1, 3 and 6 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,934,380 to de Toledo (hereinafter: "de Toledo"). Claims 1, 4 and 6 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,640,970 to Arenas (hereinafter: "Arenas"). Claim 5, which was not included in these rejections, depended on claim 1. Claim 1 was amended in the response filed March 1, 2006, to include the limitations of claim 5 and to include additional limitations. Claim 1 as amended, therefore, corresponds to claim 5 rewritten in independent form, but being further limited.

Since claim 5 was not rejected in the first action over de Toledo and Arenas, claim 5 rewritten in independent form could not properly be finally rejected over these references in the present action. Similarly, a claim which corresponds to claim 5 rewritten

in independent form and which is further limited, i.e., claim 1 as amended in the response to the first action, can also not be properly finally rejected over these references in the present action.

Therefore, the finality of the present action is improper. Withdrawal of the finality of the action is in order and is respectfully requested.

Request for Reconsideration of the 35 U.S.C. § 103(a) Rejections

Claims 1, 3 and 6 are rejected in the present action under 35 U.S.C. 103(a) as being unpatentable over de Toledo (U.S. Patent No. 4,934,380). Claims 1, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arenas (U.S. Patent No. 5,640,970).

The position of the Office with respect to de Toledo is that de Toledo discloses all of the elements of Claim 1 of the present application except for the proportion of the length of the insertion of the tapered portion into the receiving portion.

Applicants respectfully submit, however, that de Toledo does not disclose all of the elements of the guide wire recited in claim 1 other than the proportion of the length of the insertion of the tapered portion into the receiving portion and that, therefore, de Toledo cannot support a case of *prima facie* obviousness of claims 1, 3 and 6 under 35 U.S.C. § 103(a).

More particularly, de Toledo does not disclose the characteristic feature of the present invention wherein one of the ends of the adjacent coil wires is formed into a tapered portion gradually reducing in outer diameter toward the end. In the section identified by the Office (Col. 4, lines 10-14; lines 28-32), coil 14 is described as having a proximal portion 44 with an outer diameter of about 0.035 inch, i.e., a first portion having a constant outer diameter, and a distal portion 48 having an outer diameter of about 0.035 inch, i.e., a second portion having a constant outer diameter. The coil tapers only between the proximal portion 44 and the distal portion 48 in the region 46. (Refer to Fig. 1).

The adjacent coil wires disclosed in de Toledo are joined by removing wire material from the outer diameter of the first coil to a depth substantially equal to the diameter or thickness of the wire forming the second coil to provide a smooth flat surface on the first coil for joining of the second coil (Col. 4, lines 28-38). In contrast to the guide wire of de Toledo which requires removal of wire material from the outer diameter of the first coil, the guide wire of the present invention provides an effect that connecting the coil wires can easily be performed within a short time by forming one of the ends of the adjacent coil wires into a

tapered portion gradually reducing in outer diameter toward its end.

De Toledo, therefore, does not support the 35 U.S.C. § 103(a) rejection.

The position of the Office with respect to Arenas is also that Arenas discloses of the elements of Claim 1 of the present application except for the proportion of the length of the insertion of the tapered portion into the receiving portion.

Applicants respectfully submit, however, that Arenas does not disclose all of the elements of the guide wire recited in claim 1 other than the proportion of the length of the insertion of the tapered portion into the receiving portion and that, therefore, Arenas cannot support a case of *prima facie* obviousness of claims 1, 4 and 6 under 35 U.S.C. § 103(a).

In Arenas, the coil wires 28, 36 are not fitted onto the mounting portion of the core wire in tandem and are not adjacent in the axial direction of the core wire. Coils of the coil wire 36 are interwoven or interleaved with coils of the coil wire 28 (Col. 4, lines 18-20). Both coil wires 28, 36 extend to the tip member (Col. 4, lines 24-26) and a most distal coil wire does not exist. Additionally, the pitch of the receiving end portion of the coil wire into which the tapered portion is inserted is constant and the

pitch ahead of the receiving end portion is formed to be larger than that of the remaining portion (Col. 4, lines 20-24 and Figs. 2 and 3). Such a guide wire as disclosed in Arenas makes it more difficult to connect the coil wires than the guide wire of the present invention.

Arenas, therefore, does not support the 35 U.S.C. § 103(a) rejection.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arenas in view of Finlayson (U.S. Patent No. 5,551,444). The propriety of this rejection depends upon the rejection of claim 1 over Arenas. Since the rejection of claim 1 over Arenas is not proper, claim 2 is allowable.

Removal of the 35 U.S.C. 103(a) rejections of the claims is believed to be in order and is respectfully requested.

The foregoing is believed to be a complete and proper response to the Office Action dated April 24, 2006, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of

time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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